

REMARKS/ARGUMENTS

Application Status

Claims 1, 3, and 6 were pending in the subject application. Claims 1, 3, and 6 were rejected. No claims were allowed. By this amendment, claim 1 has been revised and claim 3 has been canceled. Therefore, claims 1 and 6 are now pending and before the examiner for consideration.

Rejection Under 35 U.S.C. § 112 First Paragraph

In the Office Action, claims 1 and 6 were rejected under 35 U.S.C. § 112, first paragraph. The Office Action alleged that the subject matter was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Office Action indicated that:

... a claim to a endonuclease of undefined structure with a roadmap of where the protein can be isolated from. The scope of the claims includes numerous structural variants, and the genus is highly variant because a significant number of structural differences between genus members is permitted, given that the claims do not recite any structural limitations. Since the disclosure fails to describe the common attributes or characteristics that identify members of the genus, and because the genus is highly variant, Applicant's single enzyme, alone is insufficient to describe the genus.

In the Office Action, claim 3 was indicated to meet the written description requirement of 35 U.S.C. § 112, first paragraph. Claim 1 has been amended to include all limitations of claim 3. Accordingly, withdrawal of the rejection of claims 1 and claim 6 (which depends from claim 1) is respectfully requested.

Rejection Under 35 U.S.C. § 102

In the Office Action, claims 1, 3, and 6 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kwon et al. (International Journal of Biochemistry and Cell Biology Vol. 30, February 1998, pp. 217-223, 1998; "Kwon"). The Office Action indicated that:

...Applicants Declaration recites a claim of priority under 35 USC 119 to a foreign application. However, while foreign priority may be afforded under 35 USC 119, a continuation of a PCT is not permitted under 35 USC 119. This continuation can only be made under 35 USC 120. Applicants Declaration does not recite any priority to any application under 35 USC 120.

The application was filed before the change to 35 U.S.C. §120 instituted on November 29, 2000 (see 37 C.F.R. §1.78). Thus, at the time the application was filed, a claim of domestic priority only required that the specification recite such a claim. See MPEP, 8th Ed., 201.11V (page 200-73). Such a recitation was added to the specification in the amendment mailed April 23, 2003. Accordingly, as the application is entitled to a priority date that is less than one year after the publication date of Kwon, Kwon is not a proper §102(b) reference. Withdrawal of the rejection is therefore requested.

Request for Correction of Inventorship Pursuant to 37 C.F.R. 1.48(b)

The amendments made during prosecution of the present application have resulted in there being fewer inventors indicated in the originally filed application. The deletion of Drs. Yeong Joong Jeon, Wan Je Park, Na Gyong Lee, and Sang Bo Jung is therefore requested. The processing fee set forth in 37 C.F.R. §1.17(i) is enclosed.

The inventors of the presently claimed subject matter are Drs. Hyung Joo Kwon and Doo Sik Kim- the authors of the Kwon reference. As the current inventorship entity is identical to the authorship of the Kwon reference, Kwon is also not a proper 35 U.S.C. §102(a) reference.

Conclusion

The claims currently before the examiner are supported throughout the specification and are patentable over the prior art. No new matter has been added. This application is now in full condition for allowance, and such action is respectfully requested.

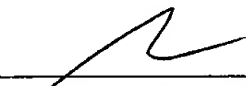
This response accompanies a Request for Continued Examination along with a petition for a two month retroactive petition for extension of time and the required fee. The Commissioner is hereby authorized to charge any underpayment of fees under 37 C.F.R. §1.16 or 1.17 as required by this paper to Deposit Account 50-0951.

The examiner is invited to call the undersigned if clarification is needed on any matter within this amendment, or if the examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

AKERMAN SENTERFITT

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